## REMARKS

This amendment is in response to the Office Action mailed September 21, 2004.

Claims 1-19 and 24-26 are allowed and will not be discussed further.

The remaining portion of this amendment addresses rejected claims 20-23. These claims are rejected under 35 USC 103(a) as being unpatentable over Hartley et al. (U.S. Patent No. 5,034,908) in view of Pocrass (U.S. Patent No. 5,428,806).

In response to this rejection applicants respectfully disagree with the Examiner and argue the claims are patentable over the art of record because they provide novel structure and benefits and the Examiner has failed to make out a prima facie case of obviousness.

### NOVEL STRUCTURE AND BENEFIT

Claim 20 as amended, in part, calls for individual word alignment select line coupled to each of the P multiplexers. The controller provides control signals on the word alignment select line to select output from a latch in each of the M parallel sets of multiple storage devices so that bits from the selected latch are arranged in a predefined location and orientation within said memory. Neither the word alignment select line nor its co-action with the signal outputted from the controller to effectuate the actions set forth in claim 20 is suggested or disclosed in the reference. As a consequence, this structure is novel. Being able to select data from different one of the serially connected latches the alignment of data in the memory is made much simpler

resulting in a benefit to the user. It is applicants' contention the novel structure and benefits are indicia of nonobviousness.

In addition, the problem solved by the invention is misalignment resulting from transmitting part of the same word over different transmission facilities (see page 26, lines 4-22, applicants' specification). This problem is not recognized in the cited reference. It is applicants' contention solving this problem together with benefits set forth above are, also, evidence of nonobviousness.

PRIMA FACIE CASE OF OBVIOUSNESS IS NOT MADE

A rejection under 35 USC 103(a) requires the Examiner to present a prima facie case of obviousness. It is applicants' contention that one is not made in this case. A prima facie case of obviousness requires, among other things, motivation for the combination and the resulting combination includes all the limitations of the rejected claim.

With respect to motivation to combine, applicants contend none of the references set forth any motivation to combine. The claimed invention is directed to a circuit arrangement that aligns groups of data bits. The primary reference U.S. Patent 5,034,908 (Hartley et al.) discloses a digital filter. There is no teaching in this patent relative to circuit for alignment. The secondary reference U.S. Patent 5,428,806 (Pocrass) relates to a computer network system in which remote units communicate with a hub located at the central location of the network. This secondary patent does not disclose or suggest a circuit or arrangement for aligning bits as is claimed by the present invention. The teaching of the references (primary and secondary) are different from the invention claimed. In this regard these references would lead an artisan away

from generating a combination that would render applicants' claim obvious. In fact, applicants contend that these references teach away from the claimed invention. Therefore, an artisan viewing these teachings would be led in the opposite direction rather than providing a combination that renders applicants' claim obvious.

Even though none of the references suggest a motivation to combine the Examiner could still make out a prima facie case of obviousness if he provides logical and concrete reasons why an artisan viewing the teachings of these references, without hindsight gleaned from applicants' disclosure, would form a combination that renders the claim obvious.

However, it is applicants' contention the Examiner has not done so. The only reason the Examiner gives why an artisan viewing the references would form a combination is set forth in the last two paragraphs of item 3 on page 3 of the Office Action. It is applicants' contention that the reason does not appear to be sufficiently concrete or logical to justify forming a combination from the prior art that renders applicants' claim obvious. Furthermore, applicants argue the Examiner seems to be picking items from the prior art and arguing that one of ordinary skill could combine them in such a way to render applicants' claim obvious. It is applicants' position that such picking without direction in the prior art or logical reason for the combination is improper.

In addition, the Examiner's combination does not meet all the limitations of applicants' claim. For example, the word alignment select line and its corporation with the controller to effectuate results set forth in the rejected claims are not present in the Examiner's combination. Therefore, even after the combination the resulting reference would not render applicants' claim obvious because these limitations and others would

not be present in the Examiner's combination. As a consequence, claims 20-23 are not obvious in view of the references.

Newly added claim 27 is also patentable for reasons set forth above.

It is believed that the present amendment answers all the issues raised by the Examiner. Reconsideration is respectfully requested and an early allowance of all the claims is solicited.

Respectfully Submitted,

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